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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, MERILYN P

ART UNIT PAPER NUMBER

2163

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/741,200	Applicant(s) CHENG, HEUNG-FOR	
	Examiner Merilyn P Nguyen	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2006.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 17 and 19-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-10, 17 and 19-25 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 10 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/28/2006 has been entered.
2. In response to the communication dated 03/28/2006, claims 1-10, 17 and 19-25 are active in this application.

Acknowledges

3. Receipt is acknowledged of the following items from the Applicant:
 - The applicant's amendment has been considered.
 - Declaration under 37 CFR 1.131 has been considered.

Affidavit Under 37 CFR 1.131

4. Indicate on record that the Declaration was filed as an Affidavit under 37 CFR 1.131. The evidence is persuasive and the rejection of claims 1-10, 17 and 19-25 under 35 U.S.C. 103(a) in view of Japanese application No. 2000259514 published on September 22, 2000 is hereby withdrawn.

Claim Rejections - 35 USC § 112

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 21, the step of “looking up the document identifier in the database to identify the distribution list” is unclear as to whether the step of looking up the document identifier occurs after receiving an error message.

Regarding claims 4, 7, 8, 17, 20, 23 and 14, these claims contain the trademark/trade name MAPI. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Exparte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe interface and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102 or 35 USC § 103

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 and 21-22 are rejected under 35 U.S.C. 102(e) as anticipated by Reilly (U.S. 6,427,164) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese publication No. 11041275A published on February 12, 1999 (hereinafter JP11041275).

Regarding claims 1 and 21, Reilly disclose: A method and an apparatus (See Fig. 2) for reducing network bandwidth wastage incident to sending an electronic document to a nonexistent member of a distribution list having multiple destination addresses for respective members (Col. 7, lines 1-65), comprising:

a machine accessible medium (memory) having stored thereon data representing set of instructions (computer readable program) which, when executed by the machine (embodied in a computer readable medium encoded with an electronic mail application program, col. 3, lines 61 to col. 4. lines 9, Reilly), cause the machine to:

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- perform receiving a document (receiving message) by a document distribution server (email server 240) (col. 6, lines 66 to col. 7, lines 26, Reilly);
- recording in a database a document identifier and the distribution list (col. 7, lines 28-62, Reilly);
- distributing the document to the members of the distribution list (col. 7, lines 28-62, Reilly);
- receiving, in response to distributing to a first member (User2) of the distribution list, an error message including the document identifier (“e-mail server 240 sends a message to the sending email server 140 indicating that the address is invalid... Sorry JOE, your message to SAM@HOSTZ.ARPA lost”, col. 7, lines 31-35 and 55-60, Reilly);
- looking up the identifier in the database so as to identify the distribution list (address book) (col. 3, lines 3-10, and col. 9, lines 49-58, Reilly, wherein an error message comprises the document identifier (i.e. username) so that username of the invalid destination address is deleted and the distribution list is updated, thus performing looking up functions).

Reilly teaches “the username for User2 may have been deleted from the list of users on the Domain2 e-mail server 240 for any one of many reasons” such as invalid or no long exist email address (See col. 7, lines 39-60). Reilly also teaches automatically updating the distribution list (address book) as the old destination address (email address) of the user2 is invalid or no longer exist and the new destination address (email address) is acknowledged, wherein the invalid destination address is responded with an error message comprising the

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document identifier (user name) (See col. 7, lines 28-62 and col. 9, lines 49-58). Because Reilly teaches automatically updating the distribution list by replacing the old email address with the new email address so that avoiding subsequent error messages, therefore it clearly addresses the claimed limitation of “automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages”.

In the alternative, the limitation of “automatically deleting the destination address for the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages” is obvious over Japanese publication No. 11041275A published on February 12, 1999 (hereinafter JP11041275). JP11041275 teaches deleting the first member from the distribution list so that a subsequent sending to the distribution list avoids corresponding subsequent error messages (“A mail server (101) holding electronic mail (E-mail) address list (102) delivers an E-mail to mail client (106) addressee based on the address list. A controller (103) deletes address of E-mail currently to be delivered from the address list, if an error message indicating delivery impossibility of mail server is received”, the Abstract).

Because Reilly allows updating the distribution list, thus at the time invention was made, it would have been obvious to a person of ordinary skill in the art to automatically delete member from the distribution list in the system of Reilly as taught by JP11041275. The motivation would have been to enable avoiding further error messages and network bandwidth caused by repeating the transmission of message to invalid addresses.

Regarding claim 2, all the limitations of this claim have been noted in the rejection of claim 1. In addition, Reilly/ JP11041275 disclose: wherein the wastage comprises bandwidth required for: the distributing the document to the nonexistent member (col. 7, lines 28-62, Reilly);

the error message received in response to the distributing (col. 7, lines 28-62, Reilly);
a reply by a second member of the distribution list, in response to the distributing, which is distributed to the nonexistent member; and an error message responsive to the reply (col. 8, lines 50 to col. 9, lines 10, Reilly).

Regarding claims 3 and 22, all the limitations of these claims have been noted in the rejection of claims 1 and 21, respectively. In addition, Reilly/ JP11041275 discloses wherein members of the distribution list receive distributions addressed such that replies to the distributions are directed to the members of the distribution list (col. 8, lines 31-49, Reilly).

7. Claims 4-10, 17-20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S. 6,427,164), or in the alternative as obvious over Japanese publication No. 11041275A published on February 12, 1999 (hereinafter JP11041275), and in view of Applicant's admitted prior art.

Regarding claims 4-7, 20 and 23-25, all the limitations of these claims have been noted in the rejection of claims 3, 17 and 22, respectively. Reilly/ JP11041275 discloses an email system, however, Reilly/JP11041275 is silent as to disclose a Messaging Application Programming Interface (MAPI) application includes an object-oriented programming language

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and having an e-mail functionality in order to compose messages. Applicant's admitted prior art discloses MAPI (See page 2-3 of specification). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the MAPI application program use for composing and disposing in the system of Reilly/ JP11041275 as suggested by Applicant's admitted prior art. The motivation being to make it easy for users to write message application that are independent of the underlying message system and implement message features with a small amount of code. Moreover, MAPI provides a consistent interface for multiple application programs to interact with multiple messaging systems across a variety of hardware platforms.

Regarding claims 8 and 17, all of the limitations of these claims have been noted in the rejection of claims 4-7 above. It is therefore rejected on similar grounds.

Regarding claims 9 and 18, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, Reilly/JP11041275 and applicant's admitted prior art disclose receiving of the error message (col. 7, lines 28-62, Reilly); receiving the electronic document by a distribution server which performs the distributing of the electronic document (col. 6, lines 66 to col. 7, lines 26, Reilly), and looking up the identifier (col. 8, lines 15-30, Reilly).

Regarding claims 10 and 19, all the limitations of these claims have been noted in the rejection of claims 8 and 17, respectively. In addition, Reilly/ JP11041275 and applicant's

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admitted prior art disclose determining the identifier based on attributes of the electronic document, the attributes including one or more of a subject identifier, a sending time, and a distribution list identifier (col. 7, lines 45-62, Reilly).


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 571-272-4026. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN
MN
April 6, 2006


DONWONG
SUPERVISORY PATENT EXAMINER